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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,078

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Kaoru Yokota

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EXAMINER

KIM, KEVIN Y

ART UNIT

PAPER NUMBER

3714

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,078	<b>Applicant(s)</b> YOKOTA ET AL.	
	<b>Examiner</b> KEVIN Y. KIM	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/30/2006</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A game program in and of itself does not constitute statutory subject matter, as it is not tied to a machine, nor does it transform underlying subject matter to a different state or thing.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3-5, 9, 11, 16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahoe et al (US 2001/0029205 A1) in view of Eguchi et al (US 6,951,516 B1).

6. Re claim 1, Tahoe discloses a game system comprising:

a stationary game execution apparatus (figure 1, 20), a monitor (figure 1, 50),  
the stationary game execution apparatus including:

an obtaining unit operable to obtain the game program and general image data,  
the game program indicating a game procedure, and the general image data being for  
display in accordance with progression of the game (figure 1, 24 and figure 3, 60-62,  
wherein game program consists of both game data and graphics data);

a write unit operable to write the obtained game program to a portable recording  
medium (figure 1, 28);

a generation unit operable to generate stationary image data from the obtained  
general data, the stationary image data being suitable for display by the stationary  
game execution apparatus (figure 1, 22);

a transmission unit operable to transmit data over a network (figure 1, 24);

an input unit operable to receive an input operation from a user (figure 1, 40);

and

an execution unit operable to execute, based on the received input operation, the  
game, in accordance with the procedure indicated by the obtained game program, and  
generate, in accordance with progression of the game, a stationary display image from  
the generated stationary image data, and output the generated stationary display image

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(figure 1, 21),

the monitor displaying the output stationary display image (figure 1, 50).

However, Taho is silent on a portable game execution apparatus, wherein a generation unit generates portable image data suitable for display by the portable game apparatus, a read, reception, input, execution, and display unit. Eguchi teaches a video game system that allows users to download video game data into a handheld video game device (column 13, lines 30-43). As the portable device is capable of playing games, it inherently contains the execution, display, and input units as disclosed above. Additionally, Eguchi teaches that the use of networks to download game data is well known (column 13, lines 7-29).

It would have been obvious to one skilled in the art at the time the invention was made to modify Taho with the methods of Eguchi to allow portable devices to download image data in order to allow players to use their portable gaming devices to transport game data, while also allowing them to play a related game with said data on the portable devices.

7. Re claim 3, see rejection to claim 1, *mutatis mutandis*.

8. Re claim 4, Taho discloses a recording medium (figure 3, 33), and

the obtaining unit obtains the game program and the general image data by reading the game program and the general image data from the recording medium (figure 3, hard disk 33 sends data to the memory card 60).

9. Re claim 5, Taho discloses a distribution server apparatus stores therein the game program and the general image data, and reads the game program and transmits

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the read game program over the network (figure 3, 33 and figure 2, 70), and

the obtaining unit obtains the game program and general image data by receiving the game program and the image data from the distribution server apparatus over the network (figure 2, 70).

10. Re claim 9, Tahoe discloses the input unit further receiving a stop instruction indicating stopping of the game at a point part way through, the execution unit generates state data indicating a state of progression of the game at the point at which the stop operation was received, and the write unit further writes the generated state information to the portable recording medium (paragraphs [0033] and [0035], game progress data).

11. Re claim 11, see rejection to claim 1, *mutatis mutandis*.

12. Re claim 16, see rejection to claim 9.

13. Re claims 19-24, see rejection to claim 1, *mutatis mutandis*.

14. Claims 2, 6-7, 10, 12-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tahoe in view of Eguchi as applied to claims 1, 3, and 11 above, and further in view of Xidos et al (US 5,851,149).

15. Re claim 2, Tahoe discloses a distribution server (figure 1, 30), including:  
a storage unit operable to store the game program (figure 3, 33);  
a read unit operable to read the game program from the storage unit (figure 3, both RAM 25 and memory card 60 are able to take data from the storage unit, and thus, it is inherent that there is a read unit);

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a transmission unit operable to transmit the read game program securely over the network (figure 2, 36),

wherein a game execution unit further includes:

a reception unit operable to receive the game program over the network (figure 1, 24); and

a write unit operable to write the received game program to a medium (figure 1, 28).

There is no disclosure as discussed above of a portable game execution apparatus in Taho, or instead of the stationary apparatus writing the game program to the portable recording medium, the mobile game execution apparatus writes the game program to a portable recording medium.

Eguchi has been discussed above regarding a portable game apparatus. Since Taho discloses a game apparatus with networking capabilities, and Eguchi teaches portable game apparatuses and networking capabilities, one skilled in the art would find it obvious to implement the networking capability discussed above into a portable game apparatus in order to allow a portable game device to have similar functionality to a standard game apparatus.

Furthermore, Eguchi teaches that the portable game device that is using portable recording medium may act as repository for data exchange between the two video game platforms (column 13, lines 39-43). Thus, the mobile game execution apparatus must be able to write a game program to a portable recording medium in order to allow the device to act as a repository, allowing users to store data onto the portable device in

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order to later write the data onto the stationary device.

Finally, the above are silent on transmitting the program securely. Xidos teaches using key cryptography to encrypt information being transmitted over a network (column 34, lines 14-28). It would have been obvious to one skilled in the art to encrypt information being transmitted in order to prevent hackers from easily accessing and intercepting transmitted data.

16. Re claim 6, Xidos teaches using key cryptography to encrypt information being transmitted over a network (column 34, lines 14-28). It would have been obvious to one skilled in the art to encrypt information being transmitted in order to prevent hackers from easily accessing and intercepting transmitted data.

17. Re claim 7, Xidos teaches using key cryptography to encrypt information being transmitted over a network (column 34, lines 14-28). It would have been obvious to one skilled in the art to encrypt information being transmitted in order to prevent hackers from easily accessing and intercepting transmitted data.

18. Re claim 8, Xidos teaches generating a key to encrypt data being transmitted over a network (column 34, lines 14-28). One skilled in the art would have found it obvious to write the key to the portable recording medium in order to ensure that the device receives the key, thus giving it the ability to decrypt the encrypted information.

19. Re claim 10, Tahoe et al do not disclose a storage unit storing address information indicating a connection location of an apparatus on the network, wherein the write unit writes address information to the portable recording medium.

Xidos teaches a networked distributed gaming system in which game



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apparatuses communicate via the TCP/IP protocol (column 3, lines 18-20). The TCP/IP protocol assigns a unique IP address to each connected client in a network. Inherently, this address must be stored on a storage unit, as data in a computer system must exist on some medium. Thus, one skilled in the art would have found it obvious to implement the TCP/IP protocol, storing the addresses on a recording medium, in order to uniquely identify users connected to a network.

20. Re claims 12-15, see the above rejections. It is inherent that the generated key in key cryptography matches on both sides of a network – otherwise, the data would not be able to be decrypted and would be unusable. It would have been obvious to use key cryptography in order to ensure transmitted data is secure.

21. Re claim 17, see rejection to claim 10.

22. Re claim 18, see rejection to claim 2, *mutatis mutandis*.

### **Conclusion**

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Olson teaches a lotto gaming apparatus and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN Y. KIM whose telephone number is (571)270-3215. The examiner can normally be reached on Monday-Thursday, alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/  
Primary Examiner, Art Unit 3714

/Kevin Y Kim/  
Examiner, Art Unit 3714